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MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

EXAMINER	
CALDWELL, ANDREW T	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SATORU MOTOYAMA

Appeal 2007-003050
Application 09/037,822
Technology Center 2400

Decided: [1] May 22, 2009

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and ST. JOHN COURTENAY, III, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 41-46. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

A. INVENTION

The invention at issue on appeal relates to temporary storage of communications data (MIDI data). (Spec. Fig. 7.)

B. ILLUSTRATIVE CLAIM

Claim 41, which further illustrates the invention, follows.

> 41. A music data processing apparatus connecting to an external device via a public communications line, comprising:
>
> a receiver that receives a series of music data each containing first time information from said external device via the public communications line;
>
> a judging device that judges whether each of said received music data is received first from the external device or not;
>
> a controlling device that rectifies said first time information by a predetermined value and sets the rectified first time information as second time information for the music data processing apparatus when said judging device judges said received music data is the first received data and does not set the first time information as the second time information when said judging device judges said received music data is not the first received data;
>
> a memory that temporarily stores said received music data; a processor that counts up the second time information periodically and processes the stored music data in accordance with said counted up second time information and the first time information contained in the music data to be processed.

C. REFERENCES

The Examiner relies on the following references as evidence:

Shioda	US 5,430,243	Jul. 4, 1995
Moline	US 5,883,957	Mar. 16, 1999 (filed Mar. 5, 1997)
Isozaki	US 5,999,905	Dec. 7, 1999 (filed Aug. 7, 1997)

D. REJECTIONS

The Examiner makes the following rejections.

The Examiner has withdrawn the rejection under 35 U.S.C. § 112, second paragraph. (Ans. 4).

Claims 41-46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moline in view of Isozaki.

Claims 41-46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moline in view of Shioda.

II. ISSUE

Has the Examiner set forth a prima facie case of obviousness? Specifically, has Appellant shown the Examiner erred in finding that Moline teaches or suggests a controlling device that rectifies said first time information by a predetermined value and sets the rectified first time information as second time information for the music data processing apparatus?

III. PRINCIPLES OF LAW

35 U.S.C. § 103(a)

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

> obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 415, and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415-16 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 415, 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 417-418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

IV. ANALYSIS

Appellant argues that the Examiner's Answer does not establish that the cited references disclose setting the time of the apparatus, where the apparatus receives time information from the first received music data and rectifies the time information (subtracts a given value), and the rectified time information is used to set the time of the apparatus. Appellant argues that there is no disclosure or suggestion that the receiver's system time, which is counted up periodically, is set based on the received time data. (Reply Br. 4.)

The Examiner, at page 5 of the Answer, maintains that Moline teaches rectifying a predetermined time/value [time delay] from time information as "the delay time period is added to the server start time", col. 13, ll. 10-11 or "the amount of track 607 that must be accumulated before receiver 619 begins playing the track is determined by a delay parameter set by the user of receiver 619(1) . . . to provide a delay parameter to receiver 619(1)", col. 12, ll. 1-6.

We disagree with the Examiner's finding that Moline teaches modifying the system clock of the receiver, as column 13, lines 8-12 of Moline disclose that "a server start time is determined which is the system time, at which the receiver 619 creates the buffer in which the stored track 805 is stored. The delay period is then added to the server start time to obtain a play start time." From this teaching, we find that Moline does not

rectify time information which is used to set back the time or clock of the apparatus. Nor do we find that the teachings of Moline at column 12 support the Examiner's position, as set forth at pages 5-9 and 11-13 of the Answer. In the Answer, the Examiner struggles by citing numerous citations to the teachings of Moline to support the Examiner's position that Moline teaches or fairly suggests setting the system clock of the receiver. While we agree that Moline teaches a similar operation in the playback of MIDI data, we find the Examiner's citations fail to support the Examiner's position. Furthermore, we find no other specific teaching or suggestion in Moline to set back the system clock of the receiver, and we find no reliance on either Shioda or Isozaki for this limitation in the claimed invention. Therefore, we find that the Examiner has not set forth a sufficient initial showing of obviousness of independent claims 41 and its dependent claims 42-44. We find similar limitations in independent claims 45 and 46. Therefore, we cannot sustain the rejections of independent claims 45 and 46.

V. CONCLUSION

For the aforementioned reasons, Appellant has established that the Examiner has not set forth a prima facie case of obviousness.

VI. ORDER

We reverse the obviousness rejections of claims 41-46.

REVERSED

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MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024